



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/921,016

08/03/2001

Glenn D. Austin

00717.00008

5841

22907

7590

06/15/2004

BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

BROWN, MICHAEL A

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/921,016	AUSTIN ET AL.	
	Examiner	Art Unit	
	Michael Brown	3764	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 and 36-42 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 21-27, 30-33 and 36-41 is/are rejected.
- 7) ☒ Claim(s) 18-20, 28-29 and 42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

Art Unit: 3764

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 4-5, 9, 12, 30-31, 33 and 41 are rejected under 35 U.S.C. 102(e) as being

clearly anticipated by Michelle.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 36 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sperry.

Art Unit: 3764

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3, 6-8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Michelle.

Michelle discloses in figure 1 a female condom, substantially as claimed. However, Michelle does not disclose the dimension of the untension spacing or the inner diameter of the inner ring. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the untension spacing between the first and second ring as disclosed by Michelle could be the same dimensions recited in claims 2-3, 6-7 and 10-11. Also the inner diameter of the ring disclosed by Michelle could be the same as the inner diameter recited in claim 8. The reason for the dimensions being the same is neither dimension is critical or provides any novelty to the invention.

7. Claims 13-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelle in view of Kassman.

Michelle discloses in figure 11 a female condom comprising a framework that includes an element 304 extending helically along a proximal pouch portion (the outer portion of the condom

Art Unit: 3764

above 301), the helical portion 304 provides a generally V-shape stay (any two connected portion of the helix provides a generally V-shape and the internal biasing means forming an outwardly recess (the ring 30 pushes the condom outward and forms a tapered portion (that forms a recess), extending towards the closed end in figure 1). However, Michelle does not disclose the internal biasing member being a plurality of stay members extending longitudinally along the distal pouch, the proximal pouch including a resilient framework or the framework including a plurality of elements extending longitudinally along the proximal pouch portion. Kassman teaches in figure 12 a female condom having a first biasing means 84, a second biasing means 104, a pouch portion (the portion of the condom between 80 and 84), a plurality of stay members 102 extending longitudinally along a distal pouch portion, the stay members make up a resilient framework and the framework is a plurality of elements extending longitudinally along the proximal pouch portion (fig. 12).

8. Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelle in view of Reddy.

Michelle discloses in figure 1 a female condom, substantially as claimed. However, Michelle does not disclose the internal biasing member comprising a resilient pad material. Reddy teaches in figures 1-3 a female condom comprising a resilient pad material 14 that is a foam that is a hydrophilic foam and polyurethane foam (col. 4, lines 50-58). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the internal biasing

Art Unit: 3764

member as taught by Reddy could be substituted for the internal biasing member as disclosed by Michelle in order to use the pad material to absorb semen. It is a matter of design to form the internal biasing member in an oval shape or ratio of the general oval shape being approximately 3:1.

9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michelle in view of Wall.

Michelle discloses in figure 1 a female condom, substantially as claimed. However, Michelle does not disclose a tubular inserter device. Wall teaches in figure 1 a female condom being inserted into the vaginal with a tubular inserter device. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the tubular inserter as taught by Walls could be used to insert the female condom as disclosed by Michelle into the vagina.

10. Claims 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sperry in view of Michelle.

Sperry discloses in figures 1-6 an assembly comprising a female condom and a tubular inserter, substantially as claimed. However, Sperry does not disclose the condom having a first biasing member and a second biasing member. Michelle teaches in figure 1 a condom comprising a first biasing member and a second biasing member, as set forth above. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the

Art Unit: 3764

condom as taught by Michelle could be substituted for the condom disclosed by Sperry because both condoms are female condoms and the first and second biasing members could be used hold the female condom in place during coitus.

***Allowable Subject Matter***

11. Claims 18-20, 28-29 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is (703) 308-2682.

M. Brown  
June 14, 2004

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a stylized flourish at the end.

**MICHAEL A. BROWN  
PRIMARY EXAMINER**